45.   The computer product of claim 43 wherein said certain preestablished data patterns include the beginning and ending of each document to be printed.

46.   The computer product of claim 33 wherein said data patterns are selected from the list including:

return address, destination address, mailing date, number of pages, type of inserts, mailing service type, postage indicia, bar codes, tracking codes, control codes.

REMARKS/ARGUMENTS

I.   General

Claims 1-46 are pending in the present application. Claims 1-16, 23, 33-40, and 46 stand rejected under 35 U.S.C. § 102. Claims 17-22, 24-32, and 41-45 stand rejected under 35 U.S.C. § 103. Claims 2-12 stand rejected under 35 U.S.C. § 112. Applicant respectfully traverses the rejections of record.

Claim 1 has been amended to set forth a more clear preamble as well as to provide more clear antecedent basis for recitation of "said printing" in claims dependent therefrom. Specifically, claim 1 has been amended to replace recitation of "said printed" with "said printing information in accordance with said data stream" in the preamble thereof. It is respectfully submitted that this amendment neither alters the scope of the claim nor introduces new matter.

Claims 2-11, 18, 34, 36, and 42 have been amended to present a scope of claim more commensurate with the invention as disclosed. Specifically, these claims have been amended to replace "is" with "comprises" with respect to the recited additional function or ancillary operation in order to provide a broader scope. No new matter has been added.

II.   The 35 U.S.C. § 112 Rejections

Claims 2-12 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, claims 2-12 stand rejected as reciting a "system" when the base claim from which they depend recites a "printer driver". Applicant has amended claims 2-19, 21, and 22 to replace recitation of "system" with "printer driver".

It is respectfully submitted that the foregoing amendments do not alter the scope of the claims and do not introduce new matter. These amended claims are asserted to be allowable over the 35 U.S.C. § 112 rejection of record.

III.   The 35 U.S.C. § 102 Rejections

The basis of the 35 U.S.C. § 102 rejection of claims 1-16, 23, 33-40, and 46 is unclear. Specifically, two pages labeled "Page 2" are included in the Office Action, wherein the first "Page 2" provides that "[c]laims 1-16; 23; 33-40; 46 are rejected under 35 U.S.C. 102(e)" and the second "Page 2" provides that "[c]laims 1-16; 23; 33-40; 46 are rejected under 35 U.S.C. 102(b)". Each such rejection relies upon Brown et al., patent number 6,337,743 (hereinafter *Brown*) as providing an anticipatory disclosure. As *Brown* is not available as a 35 U.S.C. § 102(b) reference to the present application due to the issue date thereof, it is presumed that the Examiner intended to reject claims 1-16, 23, 33-40, and 46 under 35 U.S.C. § 102(e) over *Brown*. Applicant respectfully traverses the 35 U.S.C. § 102 rejections of record.

Independent claims 1 and 23 have been amended to include limitations of dependant claims standing rejected under 35 U.S.C. § 103. Accordingly, these claims are addressed with reference to the 35 U.S.C. § 103 rejections of record.

Independent claim 33 has been amended to include the limitation originally submitted in dependent claim 35. Accordingly, claim 33 as amended presents originally submitted claim 35 in independent form. As claim 35 stands rejected under 35 U.S.C. § 102 over *Brown*, the patentability of claim 33 shall be addressed herein with reference to the rejection of record with respect to claim 35.

Claim 33, as amended, recites "said at least one ancillary operation is the printing of a postage indicia on material separate from material on which said printing is occurring." In rejecting this limitation as originally submitted in claim 35, the Examiner asserts that *Brown* teaches that "[t]he value of the perfected files in the address database become readily apparent when the lists are printed to media when forming individual mailpieces to which postage is to be applied," see the Office Action at page 3, citing column 2, lines 34-37, of *Brown*.

Initially, it should be noted that the disclosure relied upon by the Examiner in rejecting this aspect of the claims is of the prior art referenced by *Brown* and not the system taught by *Brown*. There is no disclosure of printing postage what-so-ever with respect to the system taught by *Brown*, which is relied upon in meeting the other aspects of claim 33. In order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim," see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). As no single embodiment of a mailing system in *Brown* teaches the identical invention as contained in the claim, the rejection of record does not establish anticipation under 35 U.S.C. § 102.

Moreover, even if one of ordinary skill in the art were to modify the system of *Brown* to include the identified aspect of the prior art referenced by *Brown*, the claimed invention would not be met. The language of *Brown* quoted by the Examiner teaches only that the address lists are printed on media to which postage is to be applied. There is no disclosure as to what applies this postage, nor has the Examiner asserted otherwise. Moreover, there is no structure disclosed in *Brown* suitable for applying postage. Accordingly, without the benefit of hindsight gleaned from Applicant's disclosure, there is nothing in the disclosure of *Brown* to teach or suggest the limitations of claim 33.

Applicant, therefore, asserts that claim 33, as amended, is allowable over the art of record. Moreover, as dependent claims 34 and 36-46 incorporate the limitations of base claim 33, these dependent claims are asserted to be allowable over the art of record at least for the reasons set forth above with respect to claim 33.

IV. The 35 U.S.C. § 103 Rejections

Claims 17-22, 24-32, and 41-45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Brown*. Applicant respectfully traverses the 35 U.S.C. § 103 rejections of record.

"Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103," M.P.E.P. § 2141. Accordingly, when making a rejection under 35 U.S.C. § 103(a), M.P.E.P. § 706.02(j) directs the Examiner to set

forth in the Office action: (1) the relevant teachings of the prior art relied upon; (2) the difference or differences in the claim over the applied references; (3) the proposed modification of the applied references necessary to arrive at the claimed subject matter; and (4) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification. M.P.E.P. § 706.02(j) further points out that "[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply." As described further below, in each rejection made under 35 U.S.C. § 103(a) in the present Office Action, the Examiner has failed to satisfy the initial burden of establishing a proper rejection in accordance with the directives of the M.P.E.P.

Independent claim 1 has been amended to include limitations substantially as originally submitted in dependent claim 20 and, therefore, claim 1 is addressed with respect to the 35 U.S.C. § 103 rejection of record relating to claim 20. Claim 1, as amended, recites "means for creating, from said abstracted data, data for controlling the printing of said postage indicia." In rejecting a similar aspect of claim 20, the Examiner concedes that "*Brown* does not explicitly disclose: means for creating from address information data for controlling the printing of a postage indicia," the Office Action at page 9. The Examiner opines, however, that "[i]t would have been an obvious manner of design choice to modify the teachings of *Brown* to provide means for creating from address information data for controlling the printing of a postage indicia," Id. However, the 35 U.S.C. § 103 rejection of record does not provide any explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification to meet the claims as required by M.P.E.P. § 706.02(j).

It is well settled that the prior art must suggest the desirability of the claimed invention, M.P.E.P. §2143.01. However, the motivation for modifying the system of *Brown* to meet the claims supplied in the Office Action is only that the differences in the claims and the disclosure of *Brown* are an obvious matter of design choice.

The specification accompanying the present claims expressly teaches the abstracting of a data stream and utilizing the abstracted data in generating a postage indicia, see page 4, lines 9- 23. Indeed, the present application details the abstracting of a data stream associated with a document or documents allowing a single print operation to both print documents and

associated items having postage indicia thereon, see e.g., page 8, lines 10-20, and page 11, lines 5-11. In contrast *Brown* teaches a system for extracting address information from a print stream to create an address database for future use, see e.g., column 7, lines 13-23.

Applicant respectfully asserts that the Examiner is relying on impermissible hindsight in order to piece together the elements of the claims based on knowledge gleaned from Applicant's disclosure as the disclosure of *Brown* is completely silent with respect to the use of the computers and printers therein for the printing of postage indicia. Applicant asserts that without the teachings of Applicant's disclosure one of ordinary skill in the art would not find it obvious to abstract a data stream and controlling the printing of postage indicia using the abstracted data from the disclosure of *Brown*. However, the teaching or suggestion to make the claimed combination must be found in the prior art, not in Applicant's disclosure, see M.P.E.P. §2143, citing *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Thus, the motivation to combine provided by the Examiner is improper, as the motivation must be described in a prior art reference and must detail the benefits of such a modification.

Moreover, Applicant respectfully asserts that the Examiner's statement that "[s]ince the applicant has not disclosed that means for creating from address information data for controlling the printing of a postage indicia solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill, and it appears that the claimed feature does not distinguish the invention over similar features in the prior art," at page 9 of the Office Action, is immaterial to the patentability of the claim. "The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done," M.P.E.P. § 706.02(j). The 35 U.S.C. § 103 rejection of record does not met this initial burden, and instead seeks to improperly impose a burden on Applicant to establish unobviousness.

Accordingly, Applicant asserts that claim 1, as amended, is allowable over the art of record. Moreover, as dependent claims 2-19, 21, and 22 incorporate the limitations of base claim 1, these dependent claims are asserted to be allowable over the art of record at least for the reasons set forth above with respect to claim 1.

Independent claim 23 has been amended to include limitations substantially as originally submitted in dependent claim 29 and, therefore, claim 23 is addressed with respect

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to the 35 U.S.C. § 103 rejection of record relating to claim 29. Claim 23, as amended, recites:

> maintaining in a secure memory an amount available for controlling the generation of a postage indicia calculating under joint control of said secure memory and said separate data stream an amount of postage to be applied to a particular document to be printed; and deducting said calculated postage amount from said secure memory if said calculated postage amount is available in said secure memory.

In rejecting claim 29, the Examiner concedes that *Brown* does not explicitly disclose these limitations at page 13 of the Office Action. The Examiner opines, however, that it would have been an obvious manner of design choice to modify the teachings of *Brown* to provide these limitations, Id. However, the 35 U.S.C. § 103 rejection of record does not provide any explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification to meet the claims as required by M.P.E.P. § 706.02(j).

As discussed above, the prior art must suggest the desirability of the claimed invention, M.P.E.P. §2143.01. However, the motivation for modifying the system of *Brown* to meet the claims supplied in the Office Action is only that the differences in the claims and the disclosure of *Brown* are an obvious matter of design choice.

The specification accompanying the present claims details the abstracting of a data stream and the use of abstracted information to control the generation of postage indicia via a postage control device, see page 9, lines 17-27, page 12, lines 22-23, and page 13, lines 3-9. As discussed above, *Brown* merely teaches a system for extracting address information from a print stream to create an address database for future use, see e.g., column 7, lines 13-23.

Applicant respectfully asserts that the Examiner is relying on impermissible hindsight in order to piece together the elements of the claims based on knowledge gleaned from Applicant's disclosure as the disclosure of *Brown* is completely silent with respect to maintaining in a secure memory an amount available for controlling generation of postage indicia, calculating under joint control of the secure memory and a separate data stream abstracted from a data stream an amount of postage to be applied, and deducting the calculated postage from the secure memory. Applicant asserts that without the teachings of

Applicant's disclosure one of ordinary skill in the art would not find it obvious to have modified the system disclosed in *Brown* to meet the limitations of the present claim. However, the teaching or suggestion to make the claimed combination must be found in the prior art, not in Applicant's disclosure, see M.P.E.P. §2143, citing *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Thus, the motivation to combine provided by the Examiner is improper, as the motivation must be described in a prior art reference and must detail the benefits of such a modification.

Moreover, Applicant respectfully asserts that the Examiner's statement at the bottom of page 13 of the Office Action that since Applicant has not disclosed that the above identified limitations solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill, and it appears that the claimed features do not distinguish the invention over similar features in the prior art, improperly attempts to shift the initial burden with respect to the determination of patentability to the Applicant. As discussed above with respect to claim 1, "[t]he initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done," M.P.E.P. § 706.02(j). The 35 U.S.C. § 103 rejection of record does not met this initial burden, and instead seeks to improperly impose a burden on Applicant to establish unobviousness.

Accordingly, Applicant asserts that claim 23, as amended, is allowable over the art of record. Moreover, as dependent claims 24-28 and 30-32 incorporate the limitations of base claim 23, these dependent claims are asserted to be allowable over the art of record at least for the reasons set forth above with respect to claim 23.
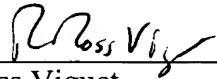
V.   Summary

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned **"Version with markings to show changes made."**

In view of the above, each of the presently pending claims in this application are believed to be in immediate condition for allowance. Accordingly, the Examiner is

respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue.

Dated: December 10, 2002   Respectfully submitted,

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Version With Markings to Show Changes Made

1.   (Amended) A printer driver for association with a data stream being presented to a printer, said data stream adapted to enable said printer to print on one or more sheets of paper information in accordance with said data stream, said data stream containing certain data bits useful for controlling functions additional to said [printed] printing information in accordance with said data stream, said driver comprising:

means for abstracting at least a portion of said certain data bits from said data stream; [and]

means for using at least some of said abstracted data for controlling at least one of said additional functions, wherein said at least one of said additional functions comprises printing of a postage indicia; and

means for creating, from said abstracted data, data for controlling the printing of said postage indicia.

2.   (Amended) The [system] printer driver of claim 1 wherein said at least one additional function [is] comprises the printing of address information on material separate from said printing.

3.   (Amended) The [system] printer driver of claim 1 wherein said at least one additional function [is] comprises the printing of a postage indicia on material separate from said printing.

4.   (Amended) The [system] printer driver of claim 1 wherein said at least one additional function [is] comprises a dialog box for allowing options from a user.

5.   (Amended) The [system] printer driver of claim 1 wherein said at least one additional function [is] comprises accepting additional data from another source.

6.   (Amended) The [system] printer driver of claim 1 wherein said at least one additional function [is] comprises directing the abstracted portion to multiple locations.

7.   (Amended) The [system] printer driver of claim 1 wherein said at least one additional function [is] comprises storage in a memory.

8.   (Amended) The [system] <u>printer driver</u> of claim 1 wherein said at least one additional function [is] <u>comprises</u> directing the abstracted portion to a viewable medium.

9.   (Amended) The [system] <u>printer driver</u> of claim 1 wherein said at least one additional function [is] <u>comprises</u> the changing of form of the data.

10.   (Amended) The [system] <u>printer driver</u> of claim 1 wherein said at least one additional function [is] <u>comprises</u> the delivery of said data to a location remote from said printer driver.

11.   (Amended) The [system] <u>printer driver</u> of claim 1 wherein said at least one additional function [is] <u>comprises</u> the change in location and/or format of the data based upon an interaction between certain data in said data stream and data stored in said printer driver.

12.   (Amended) The [system] <u>printer driver</u> of claim 1 wherein said printer driver is operable on said data stream coming from a program operating in a computing device to control at least a portion of the printing of said printer.

13.   (Amended) The [system] <u>printer driver</u> of claim 12 wherein said printer driver is located remote from said computing device.

14.   (Amended) The [system] <u>printer driver</u> of claim 12 wherein said printer driver is located within said printer.

15.   (Amended) The [system] <u>printer driver</u> of claim 12 wherein said abstracting means includes:
        means for examining said data stream for certain preestablished data patterns.

16.   (Amended) The [system] <u>printer driver</u> of claim 15 wherein said data patterns are selected from the list including:
        return address, destination address, mailing date, number of pages, type of inserts, mailing service type, postage indicia, bar codes, tracking codes, control codes, graphics, application types.

17.   (Amended) The [system] <u>printer driver</u> of claim 15 wherein said certain preestablished data patterns include the beginning and ending of postage indicia data.

18.   (Amended) The [system] <u>printer driver</u> of claim 15 wherein said additional function [is] comprises the printing of said postage indicia on a document other than the document to which said data stream is being directed.

19.   (Amended) The [system] <u>printer driver</u> of claim 15 wherein said certain preestablished data patterns include the beginning and ending of address information contained within said data stream.

Claim 20 has been canceled.

21.   (Amended) The [system] <u>printer driver</u> of claim 15 wherein said certain preestablished data patterns include the beginning and ending of each document to be printed.

22.   (Amended) The [system] <u>printer driver</u> of claim 15 wherein said certain preestablished data patterns include the number of pages of a document.

23.   (Amended) The method of printing certain information on a printed document, said method comprising the steps of:

sending a data stream to a printing device so that said printing device may print one or more documents from said data stream;

reviewing said data stream to create therefrom a separate data stream for controlling additional functions with respect to said printing of said documents;

<u>maintaining in a secure memory an amount available for controlling the generation of a postage indicia;</u>

<u>calculating under joint control of said secure memory and said separate data stream an amount of postage to be applied to a particular document to be printed; and</u>

<u>deducting said calculated postage amount from said secure memory if said calculated postage amount is available in said secure memory.</u>

Claim 29 has been canceled.

33.   (Amended) A computer program product for use in association with a data stream being directed to a general purpose printer, said data stream adapted to enable said printer to print information in accordance with said data stream, said computer product comprising:

an abstracting program operable for reviewing said data stream to obtain therefrom information for controlling printing operations ancillary to said printing operation; and

a controller working in cooperation with said abstracting program and with said obtained information for enabling at least one said ancillary printing operation, <u>wherein said at least one ancillary operation comprises the printing of a postage indicia on material separate from material on which said printing is occurring</u>.

34.   (Amended) The computer product of claim 33 wherein said at least one ancillary operation [is] comprises the printing of address information on material separate from material on which printing is occurring.

Claim 35 has been canceled.

36.   (Amended) The computer product of claim 33 wherein said one ancillary operation [is] <u>comprises</u> the acceptance of data from a source other than said data stream.

42.   (Amended) The computer product of claim 40 wherein one said ancillary operation [is] <u>comprises</u> the printing of said postage indicia on a document other than the document to which said data stream is being directed.